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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,010	02/09/2001	Gordon James Smith	ROC920000267US1	6426

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EXAMINER	
NGUYEN, TAN D	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/781,010	SMITH, GORDON JAMES	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 21-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 and 21-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The amendment filed 5/24/04 has been entered.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-9 are directed to "A method of automating charitable contributions in a gaming system", which is not within one of the classes of invention set forth in § 101.

The "method of automating charitable contributions in a gaming system" comprising the steps of (a) prompting a user with a gaming options, (b) enabling the user to pledge a contribution to an organization, (c) permitting the user to maker a wager and partake in the gaming option, and (d) automatically making the contribution to the organization based on the pledge of step (b) and the results of step (c), as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "method of automating charitable contributions in a gaming system" comprising the steps of (a)-(d) as shown fail to overcome the 2-prong test:

1) merely an abstract idea and

2) does not reduce to a practical application in the technological arts (inclusion of computer/computer automation in the body of the claims) and are therefore are found to be non-statutory. See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

Claim Rejections - 35 USC § 112

3. Claims 21-27, 28-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 21, 28, the phrase "user pledge to an organization" is vague because it's not clear what kind of pledge it refers. From the specification, it appears this refers to "pledge a contribution to an organization" such as shown in claim 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being obvious over INTERLOTTO Article (Article "InterLotto..Lottery) in view of Jaffe's Article ("Beware Charity Season Scams").

As for independent claim 1, INTERLOTTO discloses a method for automating contributions in a gaming system comprising:

(a) prompting the user with a gaming option;

(b) enabling the user to make a contribution to an organization;

(c) permitting the user to make a wager and partake in the gaming option in said automated gaming system; and

(e) automatically making a contribution to the organization.

See abstract. Note that the game system is carried out completely on the Internet system, therefore the contribution step is carried out automatically.

INTERLOTTO Article fairly teaches the claimed invention except for enabling the user to pledge a contribution in step (b), and carrying out steps (c), (d) and (e) based on the pledge of step (b).

In a case dealing with charity and gaming management, JAFFE Article discloses an idea of a charity holding a lottery game with the promise (or pledge) to the customer of a chance to win prizes in exchange for donations {see page 2, about middle paragraph} *). In other word, JAFFE Article disclose the use of a pledge for a chance of winning lottery game in exchange for giving to donation, or in other word, by pledging to make a contribution or donation to charity, one increases one's chance of winning the lottery game. Therefore, it would have been obvious to modify the teaching of INTERLOTTO Article by enabling the user to make a pledge for a contribution to charities as mentioned by JAFFE Article if this would increase the chance of wining the lottery game as taught by JAFFE Article above and wherein making money (winning the lottery) is more

important than the noble feeling "joy of charity is in the giving, not in winning the prize".

Note that even though JAFFE Article discloses that charities seldom hold lottery (sweepstakes) because of 1) "joy of charity is in the giving, not in winning the prize" and 2) currently it's maybe illegal in the United States for a sweepstakes to require purchases or donations to enter and win. However, because legality is not an issue of patent application since this issue can change with time and place, it would have been obvious to apply the teachings of JAFFE Article in INTERLOTTO Article if making money is more important than the noble feeling and legality is not an issue. Note that local government or state can make law or change the law overnight depends on the citizen's opinions of the moment. See the Article "Lure of Sweeptakes?" It's Human nature" in the conclusion.

As for dep. claim 2, the selection of the type of organization is non-essential to the scope of the claimed invention and is fairly taught in INTERLOTTO (last paragraph "players select...) or JAFFE Article.

As for dep. claim 3, since JAFFE Article teaches that the charity organization can make promise to the user that the user's chance of winning the prize depend on the user's donation to charity (in exchange for donation) {see page 2, middle paragraph}, it would have been obvious to further allow the user to select a size of contribution based on risk/reward calculation or his desire of improving the chance of winning the prize.

As for dep. claim 4, which discloses 2 odds of winning which are: (1) based on (a) and (2) based on pledge or (b), the 1st odd of winning is taught in INTERLOTTO Article alone and the 2nd odd of winning is based on INTERLOTTO Article in view of JAFFE Article.

As for dep. claim 5, this is rejected for the same reason set forth in the 1st part of dep. claim 4 above.

As for dep. claim 6, the term "payout" reads over "winning" or a result of winning, there it's rejected for the same reason set forth in claim 4 above.

As for dep. claim 7, the limitation of "1st payout" is the same as "1st winning" and similarly for 2nd payout or 2nd winning and are shown in dep. claims 4-5 and are rejected for the same reason as in dep. claims 4-5 above.

As for dep. claim 8, this is taught on 2nd paragraphs "all winnings are forwarded immediately into player's InterLotto accounts" which indicates the accumulating of the winnings and contributions during a series of gaming activities.

6. Dep. claim 6 is rejected (2nd) under 35 U.S.C. 103(a) as being unpatentable over INTERLOTTO / JAFFE Article as applied to claims 1-5, 7-8 above, and further in view of TORANGO (US 2003/00600279).

As for dep. claim 6, the teachings of INTERLOTTO / JAFFE Article is cited above. TORANGO is cited to show well known teaching in the gaming art which is as the participant contributes more to the game prize, the odds of winning the prize becomes smaller, giving the participant a better chance at winning the prize {see Fig. 7, [0102]}. In other word, as % of contribution goes

up, the odds or winning becomes smaller or the chance of winning goes up or % winning is direct proportional to the % of contribution of game prize (i.e. investing 50$ by buying 2 lottery tickets at $25.00/ticket has more chances of winning the prize than investing only $25 by buying 1 lottery ticket at $25.00/ticket). The total contribution to the game or the total cost to the player can be in the form of the buying more tickets or portion or giving more to charity or donation in this case. Therefore, it would have been obvious to modify the gaming step of INTERLOTTO/JAFFE Article by tying the winning percentage to the level of contribution to charities (or overriding the 1st incentive with a 2nd incentive selected from the group consisting of a 2nd odds of winning and a 2nd payout, wherein the 2nd incentive is greater than the 1st incentive) as taught by TORANGO to encourage increase the level of contribution to charities and chances for winning.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over INTERLOTTO / JAFFE Article as applied to claims 1-8 above, and further in view of ZIARNO (US 6,253,998).

As for dep. claims 9 (part of 1), the teaching of INTERLOTTO/JAFFE Article is cited above. In another fundraising process, ZIARNO is cited to teach the use of a receipt generator (820) to mail or fax or send/forward multiple copies of the contribution to the contributor or attender or other agency for tax purposes since the contribution to charities is normally tax deductible (Fig. 15a, col. 9, lines 5-47). ZIARNO mentions that format can be accepted by the IRS which inherently monitor individual tax related issues or return. Therefore, it would

have been obvious to modify the process of INTERLOTTO/JAFFE Article by automatically providing the information regarding the gaming option and the contribution the IRS as taught by ZIARNO to monitor tax related information if desired. Since everything in INTERLOTTO is done on the Internet, this step can be carried out automatically along with other functions.

8. Claims 21-25, 27, 28-30 are rejected under 35 U.S.C. 103(a) as being obvious over INTERLOTTO Article (Article "InterLotto..Lottery) in view of Jaffe's Article ("Beware Charity Season Scams").

As for Independent claim 21 which deals with the apparatus to carry out the method of claim 1, it's rejected over the system of INTERLOTTO Article in view of JAFFE Article. Alternatively, the set up of an equivalent apparatus to carry out an equivalent method of claim 1 would have been obvious to a skilled artisan.

As for dep. claim 22 (part of 21 above), the interactive feature is inherently included in the teaching of INTERLOTTO Article which discloses a web site and the user has the ability to input/enter selection variables. Alternatively, it would have been obvious to have an interactive step to allow more effective and dynamic interaction between the user and the gaming apparatus. As for the prompting of the user option for the pledge, this is fairly taught in view of JAFFE Article above and would have been obvious to do so in view of the questionable/illegal practice of donation/winning in the lottery game and provide an option for the user not to practice the illegal practice if desired.

As for dep. claim 23, this limitation of "determining the result based on a random process" is inherently included in the lottery game of INTERLOTTO Article since lottery is normally a game of chance and depends on a random process.

As for dep. claim 24, this is fairly taught in the teachings of INTERLOTTO Article/JAFFE Article wherein a favorable result probability to the user is formed if he makes a promise/pledge of contribution of a portion of winning prize to charities.

As for dep. claim 25 which has similar limitation as in dep. claim 3 above, it's rejected for the same reason set forth in dep. claim 3 above.

As for dep. claim 27 which talks about the user device comprises an interactive visual display terminal, the interactive feature is inherently included in the teaching of INTERLOTTO Article which discloses a web site and the user has the ability to input/enter selection variables.

As for Independent claim 28 which discloses a program product for use in an automatic gaming apparatus and the processor to carry out the same steps as in Independent claim 21, it's rejected over the program product to carry out the Internet-based lottery of INTERLOTTO Article in view of JAFFE Article.

As for dep. claims 29-30 which have the same limitation as in dep. claims 22-24, they are rejected for the same reasons set forth in claims 22-24 above.

9. Claims 26, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over INTERLOTTO / JAFFE Article as applied to claims 21-25,

27 and 28-30 respectively above, and further in view of ZIARNO (US 6,253,998).

As for dep. claims 26, 31(part of 21 and 28 respectively), the teaching of INTERLOTTO/JAFFE Article is cited above. In another fundraising process, ZIARNO is cited to teach the use of a receipt generator (820) to mail or fax or send/forward multiple copies of the contribution to the contributor or attender or other agency for tax purposes since the contribution to charities is normally tax deductible (Fig. 15a, col. 9, lines 5-47). ZIARNO mentions that format can be accepted by the IRS which inherently monitor individual tax related issues or return. Therefore, it would have been obvious to modify the process of INTERLOTTO/JAFFE Article by automatically providing the information regarding the gaming option and the contribution the IRS as taught by ZIARNO to monitor tax related information if desired. Since everything in INTERLOTTO is done on the Internet, this step can be carried out automatically along with other functions.

Response to Arguments

10. There are no arguments submitted but mere remarks about the pledge. Applicant should submit an argument under the heading "Arguments/Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. NPL:

1) The article "Subscribers can take ppv on the Fly" is cited to teach well known concept of higher % contribution to the game prize increases consumer's chance in winning the sweeptakes game. "Each movie bought (or more money spent) increases a consumer's chances in the sweepstakes".

2) The article "Lure of Sweepstakes? It's human nature" is cited to teach general tips on sweepstakes of which " *It's illegal for a sweepstakes to require purchase or donations to enter and win. Buying a product doesn't increase your chances."

3) The Article "Senate ...Elderly" is cited to teach Federal low does not require consumers to buy anything to play a sweepstakes game. Still, a large number of consumers believe it will increase their chances of winning if they buy.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113 or http://pair-direct@uspto.gov.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn
August 5, 2004

DEAN T. NGUYEN
PRIMARY EXAMINER